

## REMARKS

The Examiner is thanked for the careful review of this application.

Claims 1-3, 5, 6, and 8-19 are pending in the present application. Claims 1, 5, 8, 11, and 14-21 are independent claims. Claims 20-21 are added by this Amendment.

It is believed that this Amendment, in conjunction with the following remarks, places the application in immediate condition for allowance or at least presents the claims in better form for consideration on Appeal. Accordingly, entry of this Amendment and favorable consideration of the application are respectfully requested in view of the foregoing amendments and the following remarks.

### *Reply to The Office's Response to Arguments*

Since the Office has maintained the prior rejections and has provided arguments in support of this position, the Applicants will address the Office's response first. Specifically, the Office has maintained the rejection to claims 1-3, 5, 6 and 8-19 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,985,882 ("Del Sesto") in view of U.S. Patent No. 6,269,157 ("Coyle").

In the Office's response, it was alleged that the references were attacked individually and that it would be obvious to combine Del Sesto with Coyle to arrive at Applicants' claimed invention. The Applicants respectfully disagree.

As discussed in the Applicants' response filed on January 15, 2008, the Del Sesto patent is directed to a negotiation between a product developer/seller and an advertiser related to the price the product seller must pay to the advertiser for a given amount of advertising units. When the product developer/seller and advertiser can agree upon the price, the advertiser allocates the agreed-upon amount of advertising units to the product seller for advertising its products. Del

Sesto is being combined with Coyle to compensate for Del Sesto's failure to disclose that the advertiser is capable of selling the advertised products itself.

Coyle discloses that a moderator can control bidding, between different carriers, switches and data routes that connect carriers to their customers. *See Coyle, Column 7, lines 29-44.* The carriers can adjust their bids when they want to encourage or discourage traffic on certain routes. The Office has cited to Coyle at column 15, lines 13-14, which discusses that end users (e.g., calling parties) are not necessarily bound by the bidding process, but rather can obtain the lower of the lowest bid price and a pre-negotiated contract price with their primary carrier. Thus, end-users are not necessarily locked into their contract prices, but could receive services at lower costs via the auction.

In contrast to the teachings of the aforementioned references, the Office reads the “first modification to the first data... wherein the clients of the first multiple provider entities *are capable of purchasing* the at least one of the *one or more products* according to the first modification of the first data” as recited in claim 1, for example, upon Del Sesto's description of a counter-offer in a price negotiation for advertising space. *See 4/21/2008 Office Action, Page 5. However, the price of an advertisement is not relevant to the purchasing one or more products to which the advertisement is targeted.*

For example, an embodiment disclosed in the present Specification describes a negotiation between a product developer and a carrier that relates to how the product is to be offered to clients of the carriers. For example, the carrier may want to charge *its customers* more or less than a price proposed by the product developer for its products. In this example, the claim language of “wherein the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products *according to the first modification of the*

*first data*” as recited in claim 1 (emphasis added), for example, may read upon the agreed-upon price at which *the clients* can buy the advertised product.

In Del Sesto, clients do not *purchase products* based on the *price of the advertisement* (upon which the Office reads the claimed “first modification”) *that advertises the products*, and as such, Del Sesto does not disclose that viewers of the advertisement purchase the product “*according to the first modification of the first data.*” The Office can appreciate that advertisements do **not** typically include an indication of the cost of the *advertisement*, but rather information, such as the cost, of the *product*. Accordingly, the modification of the advertisement price does not teach “purchasing the at least one of the one or more products according to the first modification of the first data”, as alleged.

Additionally, the Office’s citation to Coyle does not cure the fundamental difference of the advertising cost in Del Sesto being irrelevant to a viewer’s purchasing decision. The Office alleges that “Coyle discloses wherein the clients of the first multiple provider entities are capable of purchasing the at least one of the one or more products.” See 4/21/2008 Office Action, Page 6. Even assuming for the sake of argument that the Office’s interoperation is correct (which the Applicants do not admit), Coyle does not disclose or suggest having a consumer purchase an advertised product *based on the cost of placing the advertisement to the product developer*. Because Coyle does not provide such a teaching, the Applicants respectfully submit that Coyle cannot cure Del Sesto’s failure to disclose “wherein the clients of the first multiple provider entities are capable of *purchasing* the at least one of the *one or more products according to the first modification of the first data*” as recited in claim 1 (emphasis added) and similarly recited in independent claims 5, 8, 11 and 14-19.

The Applicants respectfully submit that in view of the foregoing and the prior response, the Applicants have not merely argued against the references individually, as alleged in the

Office's Response to Arguments. Clearly, the combination of the references does not disclose or suggest Applicants' claimed combinations as detailed in the foregoing. The fact that the deficiencies in the references have been addressed individually in respect to each teaching alleged is not attacking the references individually, but merely correcting the record regarding the specific teachings alleged by the Office.

Further, regarding the Office's reliance on KSR, the Applicants respectfully submit that KSR does not cure the deficiencies discussed above. The recently published "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*", (hereinafter "KSR Guidelines") states the basic requirement for a finding of obviousness as clearly articulated in the following.

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

As discussed in the foregoing arguments, both Del Sesto and Coyle fail to teach all of the features of the Applicants' claimed combinations. Accordingly, these references do not support a "finding that the prior art included each element claimed" as still required under KSR (see, e.g., (1) in the quotation above). Likewise, as discussed in detail in the foregoing arguments, the alleged combination does not meet the requirement "that in combination, each element merely would have performed the same function as it did separately," (see, e.g., (2) in the quotation above). Since the references and their alleged combination do meet the KSR requirements as discussed above, the rejections under 35 U.S.C. § 103(a) should be withdrawn.

Accordingly, the Applicant respectfully requests that the Office withdraw this art grounds of rejection, and further requests issuance for the present application at least for the reasons expressed above.

### **SUMMARY**

As noted earlier, claims 1-3, 5, 6 and 8-19 remain rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,985,882 ("Del Sesto") in view of U.S. Patent No. 6,269,157 ("Coyle"). The Applicants once again traverse this rejection.

The Applicants expressly maintains the reasons from the prior responses to clearly indicate on the record that the Applicant have not conceded any of the previous positions relative to the maintained rejections. For brevity, the Applicants expressly incorporate the prior arguments presented in the January 15, 2008 response without a literal rendition of those arguments in this response.

For at least the foregoing reasons and the reasons set forth in the Applicants' response of January 15, 2008, it is respectfully submitted that claims 1, 5, 8, 11 and 14-19 are distinguishable over the applied art. The remaining dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these

claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination.

*Furthermore*, the Applicants direct the Office to newly added claims 20-21, each of which is dependent upon independent claim 1. As noted above, the Office reads the claimed “first modification to the first data” feature upon the agreed-upon price of the advertisement between the product developer and carrier, and Del Sesto fails to disclose or suggest any rationale regarding why the product developer would include the cost of placing the ad within the actual advertisement. As such, Del Sesto cannot disclose or suggest “wherein the offering step includes conveying the first data to the clients” as recited in claim 20. Coyle provides no rationale relating to why the cost of an ad would be conveyed to targets of the ad and therefore even if combinable with Del Sesto, does not teach or suggest the features of claim 20.

Likewise, for similar reasons, because the Office reads the claimed “first modification to the first data” feature upon the agreed-upon price of the advertisement between the product developer and carrier, Del Sesto in view of Coyle cannot disclose or suggest “wherein the first modification of the first data corresponds to a price that the clients pay to purchase the at least one of the one or more products” as recited in claim 21. Indeed, an attempt to read this claim limitation upon Del Sesto after the Office has read the “first modification” upon the agreed-upon cost of the advertisement would suggest that the advertised price of the product is equal to the cost of the advertisement, which Applicant submits is not necessarily the case.

Therefore, it is respectfully submitted that the rejection be withdrawn and that the claims be allowed.

### CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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By: /Fariba Yadegar-Bandari/  
Fariba Yadegar-Bandari  
Reg. No. 53,805  
(858) 651-0397

QUALCOMM Incorporated  
Attn: Patent Department  
5775 Morehouse Drive  
San Diego, California 92121-1714  
Telephone: (858) 658-5787  
Facsimile: (858) 658-2502